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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,580

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Hakon Kofoed

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09/15/2008

MORRISON & FOERSTER LLP

1650 TYSONS BOULEVARD

SUITE 400

MCLEAN, VA 22102

EXAMINER

WILLSE, DAVID H

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

09/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,580

Applicant(s)

KOFOED ET AL.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

The disclosure is objected to because of the following informalities: On page 2, lines 33 and 37, “plane” should be replaced by --planar-- (all three occurrences). Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In claims 5 and 7, a wedge part (singular) having a *varying* wedge angle is nowhere to be found in the original disclosure. In claim 6, lines 11-12, “normal” intermediate parts having substantially parallel top *and bottom* faces are not described, illustrated, or fairly suggested in the original disclosure, which instead discusses an “overall orientation [or direction: page 6, line 32; or course: original claim 6] extending approximately parallel to the auxiliary line 24” (page 6, lines 26-30). Because of the procedure for interpreting such claims as set forth in MPEP § 2163.06, prior art may be applicable to any subsequently amended claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Meanings of the terms “standard” (claim 5, line 3; claim 7, line 2) and “normal”

(claim 6, line 11) would very likely evolve over the course of an entire patent term and thus render the claims vague and indefinite as to the scope. It is recommended that structural and/or functional terminology readily understood by the ordinary practitioner be used instead to characterize the pertinent elements or features of the instant invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Leardini et al., WO 00/69373 A1, which illustrates a lower component **3**, an upper component **2**, and an intermediate part **4** having slide surfaces interacting with top and bottom slide surfaces of the upper and lower components (Figures 3a through 4c; abstract; etc.). As seen from Figure 1 (“an overall view in the sagittal plane”: page 9, lines 27-29), anterior and posterior portions of the upper component **2** and the intermediate part **4** define sagittal sections that are generally wedge-shaped. Regarding claims 2 and 3, attention is directed to page 11, line 27, through page 12, line 3; page 14, lines 23-28; etc. Regarding claims 4 and 8, tangents to points along the bearing surfaces **5**, **7**, and **8** define a continuum of wedge angles, some of which inherently lie within the specified ranges of the present claims. Regarding claims 5 and 7, the “standard part” can be viewed as one of the bars **12**.

Response to Applicant's Remarks

The Applicant's comments are directed to German patent publication no. G 88 12 806.7, the rejections based upon which have been withdrawn without prejudice in favor of Leardini et

al., WO 00/69373 A1, which the current examiner believes to be the best available art under MPEP § 706.02. (The U.S. patent related to Leardini et al., US 6,926,739 B1, was cited in the Office action mailed on October 23, 2007.) An automated English translation of said German patent publication has been generated, and a copy is attached hereto. The examiner does not see how the Applicant's intermediate part as depicted in Figure 6, including a cylindrical or conical slide surface **16**, is any more "wedge-shaped" than the elements **2** and **4** in Leardini et al. The Applicant does not provide any definition of "wedge-shaped" (in a manner prescribed in MPEP § 2111.01) that excludes the sagittal sections shown in the Leardini et al. drawings yet somehow encompasses the Applicant's own geometry. The statement on page 3, lines 2-6, of the Applicant's specification does not set forth the metes and bounds of the term with reasonable clarity, deliberateness, and precision, and there is no accompanying definition of the term "normal intermediate part" (page 3, line 6; page 6, lines 33-35).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**/Dave Willse/
Primary Examiner
Art Unit 3738**